

FEB 04 2008

Application No. 09/706,101
Filed: November 3, 2000
TC Art Unit: 3626
Confirmation No.: 5846

REMARKS

In the most recent Office Action, claims 1-3, 5-8, 10 and 15-38 were pending in the application. Claims 29-32 were withdrawn from consideration. Claims 1-3, 5-8, 10, 15-28 and 33-38 stand rejected.

In response, claims 2, 5, 7, 10, 16-26 and 28-38 are canceled. Claims 1, 3, 6, 8, 15 and 27 are amended. Accordingly, claims 1, 3, 6, 8, 15 and 27 remain pending in the present application. No new matter is added.

Applicant responds to the comments in the Office Action as follows.

Claim Objections

The Office Action states that claim 36 is objected to for incorrect phrase wording. Claim 36 is canceled from the application, thereby rendering the objection to that claim moot.

Claim Rejections - 35 U.S.C. § 112

The Office Action states that claims 1-3, 6-8, 10, 15-28 and 33-35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action states that there is a lack of antecedent basis for limitations in the claims. Claims 2, 5, 7, 10, 16-26, 28 and 33-35 are canceled from the application, thereby rendering the rejection of those claims moot. Claims 1, 3, 6, 8, 15 and 27 have been amended to more clearly recite the present invention with appropriate antecedent basis. Entry of the amendments to the claims as overcoming the rejection

Application No. 09/706,101
Filed: November 3, 2000
TC Art Unit: 3626
Confirmation No.: 5846

under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

The Office Action states that claims 1, 2, 6-7, 19, 21-23, 33 and 35-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheinuk et al. (U.S. Patent Application Publication No. 2002/0198745) in view of "Choices" (<http://www.acords.com>, 02/03/1999). In particular, the Office Action states that while Scheinuk et al. do not explicitly teach inputting restriction criteria, providing a second user interface for a third party to select a specific insured and specifying insurance coverage information relative to the specific insured to be provided in the certificate of insurance, the same is provided by Choices in an obvious combination.

Claims 2, 7, 19, 21-23, 33 and 35-36 are canceled from the application, thereby rendering the rejection of those claims under 35 U.S.C. § 103(a) as moot. Applicant respectfully traverses the rejection with respect to the remaining claims.

Claims 1 and 6 respectively recite a system and method in which certificate wording that is allowed or disallowed is stored and used to restrict the entries provided by the third party in requesting the certificate, namely the certificate holder's name, address and the purpose of the certificate. The certificate of insurance is created with the information entered by the third party, as restricted by the allowed or disallowed wording, so that creation of an unauthorized certificate of insurance is avoided.

The disclosures by Scheinuk et al. and Choices appear to discuss the simple provision of a certificate of insurance to a

Application No. 09/706,101
Filed: November 3, 2000
TC Art Unit: 3626
Confirmation No.: 5846

certificate holder. Importantly, the disclosures of Scheinuk et al. and Choices do not permit a third party to make changes related to the certificate of insurance. At most, Choices appears to indicate that a certificate holder can enter their name and address into the certificate of insurance and receive a resulting certificate through printing or viewing. In particular, neither Scheinuk et al. nor Choices disclose or suggest limiting the information entered by the third party with wording that is allowed or disallowed.

Accordingly, claims 1 and 6 recite a number of limitations that are not found in the cited prior art references, either alone or in combination with other. Applicant therefore respectfully submits that the rejection of claims 1 and 6 under 35 U.S.C. § 103(a) over Scheinuk et al. in view of Choices is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action states that claims 15-18 and 37-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheinuk et al., Choices and Leming (Chubb lets shippers review, download certificates online, Journal of Commerce, August 17, 1999) and further in view of Grow (U.S. Patent No. 6,694,315). In particular, the Office Action states that while Scheinuk et al. in view of Choices do not explicitly teach forming and entering a sentence in a certificate of insurance, the same is taught by Leming in an obvious combination.

Claims 16-18 and 37-38 are canceled from the application, thereby rendering the rejection of those claims moot. Applicant respectfully traverses the rejection with respect to claim 15. As discussed above, with respect to claims 1 and 6, neither Scheinuk et al. nor Choices teach or suggest entry and storage of

Application No. 09/706,101
Filed: November 3, 2000
TC Art Unit: 3626
Confirmation No.: 5846

certificate wording that is allowed and disallowed, which is used to restrict the entries provided by a third party for the certificate of insurance, namely a certificate holder name, address and certificate purpose. While Leming appears to discuss freeform text entered into a certificate of insurance, there is similarly no teaching or suggestion that the freeform text entered in accordance with Leming is restricted in accordance with certificate wording that is allowed or disallowed. Accordingly, none of the cited prior art references, either alone or in combination with each other, teach or suggest all of the limitations of claim 15. In addition, claim 15 is dependent upon claim 1, and should be allowable for all the reasons claim 1 is allowable, and also because of the further limitations recited in claim 15. Accordingly, Applicant respectfully submits that the rejection of claim 15 under 35 U.S.C. § 103(a) over Scheinuk et al., Choices and Leming, and further in view of Grow, is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action states that claims 3, 5, 8, 10, 24-26 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheinuk et al., Choices and further in view of Luchs et al. (U.S. Patent No. 4,831,526). In particular, the Office Action states that while Scheinuk et al. and Choices do not explicitly teach providing a certificate of insurance if an approval response is received from an approving party, the same is taught by Luchs et al. in an obvious combination.

Claims 5, 10, 24-26 and 34 are canceled from the application, thereby rendering the rejection of those claims moot. The rejection with respect to claims 3 and 8 is respectfully traversed.

-12-

WEINCARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
TEL. (617) 542-2290

PAGE 14/17 * RCVD AT 2/4/2008 10:59:56 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/36 * DNI:2738300 * CSID:6176950892 * DURATION (mm:ss):02:58

Application No. 09/706,101
Filed: November 3, 2000
TC Art Unit: 3626
Confirmation No.: 5846

The Office Action states that Scheinuk et al. teach a database operable to store information about an approving party, and operative to send an electronic message that includes at least a portion of a proposed certificate of insurance prior to generating the certificate of insurance. However, a review of the disclosure by Scheinuk et al., including paragraphs 0049 and 0089 cited in the Office Action, reveal that Scheinuk et al. is completely silent with respect to an approving party. Furthermore, Scheinuk et al. is completely silent with respect to storing information in a database about an approving party. In addition, Scheinuk et al. is completely silent regarding a computer system operative to send an electronic message to the approving party as is recited in claims 3 and 8. What is more, Scheinuk et al. is completely silent regarding an electronic message sent to an approving party that includes at least a portion of a proposed certificate of insurance. The Office Action therefore reads into the cited prior art reference of Scheinuk et al. subject matter that the reference does not, in fact, contain.

The Office Action also states that Luchs et al. teach generating an insurance document if an approval response is received from an approving party. However, the disclosure by Luchs et al. is apparently concerned only with automated issuance of insurance policies and premium quotes for insurance policies. Accordingly, any approval mentioned in the disclosure by Luchs et al. is related only to issuing an underlying insurance policy, not a certificate of insurance. Because claims 3 and 8 are directed to issuing a certificate of insurance and indicating the need for obtaining approval prior to issuance of the certificate, claims 3 and 8 recite limitations not found in the cited prior art

Application No. 09/706,101
Filed: November 3, 2000
TC Art Unit: 3626
Confirmation No.: 5846

references of Scheinuk et al., Choices or Luchs et al., either alone or in combination with each other. Because the cited prior art references of Scheinuk et al., Choices and Luchs et al. are silent with respect to the above elements, Applicant respectfully submits that a *prima facie* case of obviousness has not been established against claims 3 and 8.

In addition, claims 3 and 8 ultimately depend and further limit claims 1 and 6, respectively, and should be allowable for the same reasons that claims 1 and 6 are allowable, as discussed above, and also because of the further limitations recited in each of the dependent claims. For all the above reasons, Applicant respectfully submits that the rejection of claims 3 and 8 under 35 U.S.C. § 103(a) over Scheinuk et al., Choices and further in view of Luchs et al. is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action states that claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheinuk et al. in view of Choices and further in view of McKee et al. (U.S. Patent No. 6,272,482). Claim 20 is canceled from the application, thereby rendering the rejection of claim 20 under 35 U.S.C. § 103(a) moot.

Conclusion

In view of the above amendments and discussion, Applicant respectfully submits that the application is now in condition for allowance, and earnestly solicits notice to that effect. The Examiner is encouraged to telephone the undersigned attorney to

Application No. 09/706,101
Filed: November 3, 2000
TC Art Unit: 3626
Confirmation No.: 5846

discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

FRANCIS E. HAYES

By: *Brendan Kennedy*
Brendan J. Kennedy
Registration No. 41,890
Attorney for Applicant(s)

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
Ten Post Office Square
Boston, MA 02109
Telephone: (617) 542-2290
Telecopier: (617) 451-0313

BJK/dmc
362566.1

-15-

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
TEL. (617) 542-2290
FAX. (617) 451-0313

PAGE 17/17 * RCVD AT 2/4/2008 10:59:56 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/36 * DNIS:2738300 * CSID:6176950892 * DURATION (mm:ss):02:58